

The Office Action rejects claim 6 under 35 U.S.C. §102(b) as being anticipated by Sumitomo Electric Industries, Ltd. (JP 8-165582 A). Applicants respectfully traverse this rejection.

In particular, the current invention claims a component in a film forming equipment for forming a thin film on a substrate, the component having a matrix material, a first means on said matrix material for forming a first local cell, when exposed to a cleaning liquid, with the matrix material so that a first local current flows from the matrix material thereby advancing dissolution of the first means at an interface between the first means and the matrix material and allowing the removal of a film layer of the thin film from the matrix material, and a second means on said first means forming a second local cell, when exposed to a cleaning liquid, so that a second local current flows from the second means thereby advancing dissolution of the first means at an interface between the first means and the second means and allowing the removal of the film layer of the thin film from the matrix material, as recited in independent claim 6.

As agreed during the telephone conference, the electrochemical properties of the materials when dipped in a cleaning liquid do not represent mental steps.

Sumitomo teaches a terminal material provided by forming a chromium layer 2 between a gold plated layer 3 and a copper base material 1 (Abstract). The Patent Office appears to assert that the claimed features of the first and second means are inherent in the material of Sumitomo. However, Sumitomo fails to teach a component in a film forming equipment for forming a thin film, as recited in independent claim 6. The Patent Office appears to imply that the above-underlined feature has no patentable weight because it is recited in the preamble. However, Applicants disagree for at least

the following reasons.

MPEP §2111.02 first states that “[t]he determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim.” This clear statement eliminates the possibility by the Patent Office of refusing to consider the preamble outright and without further consideration. MPEP §2111.02 further states that “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claims, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

In this case, it is only by the preamble that it can be known that the subject matter defined by the claim is comprised as a component in a film forming equipment. Therefore, the preamble serves to further define the structure of the claimed article.

In addition, MPEP §2111.02 (I) clearly states that “[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation” (emphasis added). In this case, the preamble limits the structure of the claimed invention to components of a film forming equipment.

MPEP §2111.02 (II) further states that “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention” (emphasis added). In the response filed on March 4, 2009, Applicants placed clear reliance on the preamble by arguing that if the terminal

material of Sumitomo were in a film forming equipment, the terminal material would quickly become covered by the film formed by the equipment and would no longer be exposed, which would preempt the playing layer 2 from preventing corrosion and oxidation, and thus would be contrary to the teachings of Sumitomo. According to MPEP §2111.02 (II), such clear reliance on the preamble transforms the preamble into a claim limitation. Given that the preamble is now a claim limitation, Applicants submit that Sumitomo fails to teach the feature of a component in a film forming equipment for forming a thin film, as recited in independent claim 6.

For at least a combination of the above reasons, Applicants respectfully submit that claim 6 is patentable over Sumitomo, and request withdrawal of the rejection of claim 6 under 35 U.S.C. §102(b).

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is invited to contact the undersigned representative at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 referencing client matter number **026390-00028**.

Respectfully submitted,



Tarik M. Nabi
Registration No. 55,478

Customer No. 004372
1050 Connecticut Ave., N.W.
Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 857-6104
Facsimile No. (202) 857-6395

GEO:TMN